



Attorney Docket 088305-0121

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Paul Levi WILLIAMS, Jr., et al.
Title: PROVISION OF ELECTRONIC COMMERCE SERVICES
Application No.: 09/741,994
Filing Date: 12/22/2000
Examiner: M. A. Cuff
Art Unit: 3627
Confirmation No.: 7764

REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

The following is the Appellants' Reply Brief under 37 C.F.R. § 41.41, which is being filed in response to the Examiner's Answer mailed on April 21, 2006. It should be noted that this reply brief supplements the Appeal Brief filed on August 2, 2005 and Revised Appeal Brief filed November 17, 2005, and all the arguments presented therein are incorporated herein in their entirety.

As required by MPEP 1208, the following sections are provided on separate pages herein: Status of Claims; Grounds of Rejection to be Reviewed on Appeal; and Argument.

Status of Claims

The present appeal is directed to claims 1-28, which are the claims under consideration. A copy of the pending claims 1-28 were attached in the Claims Appendix (Section 12 of Appeal Brief).

Claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 are finally rejected under 35 U.S.C. § 102(a) as being anticipated by www.ediconsulting.com (document from website dated October 14, 1999; hereafter "EdisonConsulting"). Claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.ediconsulting.com, in view of U.S. patent no. 5,913,210 ("Call"), U.S. patent no. 5,862,325 ("Reed"), and U.S. patent no. 6,408,292 ("Bakalash").

Grounds of Rejection to be Reviewed on Appeal

The issue on appeal is whether the examiner erred in rejecting claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 under 35 U.S.C. § 102(a) as being anticipated by EdisonConsulting and in rejecting claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over EdisonConsulting in view of Call, Reed, and Bakalash.

Argument

Applicants herein incorporate by the reference the arguments presented in the revised appeal brief filed on November 17, 2005.

With respect to the contentions in the Examiner's Answer, applicants rebut the assertions as follows.

1. The "automatic determination by the host server..." feature recited in the pending independent claims is very different from anything disclosed in EdisonConsulting.

The functions on page 20, lines 20-27 are performed as an automated business function. That is, the host server (a programmed computer) performs the following functions: recognizes the trading partner; "knows" what trading formats and applications are acceptable to the trading partner; presents as options only those products and services that are acceptable to the trading partner; and then presents as options only those products and services that are acceptable to the trading partner. None of these functions are performed manually in sharp contrast to the manual process disclosed in EdisonConsulting.

In fact on page 5, line 25 to page 6, line 8, the specification identifies specific functions (a)-(f) that are controlled by the host server in a structured manner. No such structured processing controlled by a host server is disclosed or suggested by EdisonConsulting. As would be recognized by those skilled in the art, step (b) clearly implies an automatic determination by the host server of suitable electronic commerce products or services (for a user) based on the requirements of the trading partners that the user wishes to transact with. Please note that there is no requirement under U.S. law of the exact terms in the claims to be repeated, *ipsis verbis*, in the specification.

Therefore, the automated processing and automatic determination recited in the pending independent claims is very different from anything disclosed in EdisonConsulting and is well described in the specification as understood by one skilled in the art. The attempt by the examiner to interpret the claims based on the specification on page 5 of the Examiner's Answer appears to select specific portions of the specification instead of reading the specification as a whole for what it discloses to one skilled in the art and is hence believed to be somewhat irrelevant.

On page 7, the Examiner's Answer states "edisonconsulting.com is *silent* as to precise how it determines suitable EC/EDI products, *but it must use an automated and interactive process using a database of rules and trade partners and the Internet.*" (emphasis added). This is, of course, pure speculation and does not meet the requirements to make a *prima facie* case of obviousness let alone one for anticipation. The Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is "obvious" (or anticipated as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO's review court has made it very clear that *silence* in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966). Accordingly, applicants submit that the features recited in the pending independent claims are patentable over the applied prior art.

2. Applicants reiterate that the inherency relied on by the examiner does not meet the legal requirements for inherency.

The Examiner's Answer alleges inherent claimed use of database based on a system integrator stating that it had worked with a trading partner and hence they could perform better testing. However, this only implies that they had some expertise to do the testing. One skilled in the system integration art in the 1999-2000 timeframe would recognize that the integrators routinely did system integration on a customer by customer basis (as custom jobs) and nothing like the claimed database would necessarily be used across multiple customers in the manner recited in claim 2 (which depends from and includes all the limitations of claim 1). Accordingly, the examiner's assertion of the claimed use of the database as being *necessary* is not supportable based on the knowledge of one skilled in the art in the relevant time frame of claimed invention. Accordingly, applicants submit that the inherency relied on in the office action is erroneous.

In view of above, appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejection of the pending claims and pass this application on to allowance.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 672-5485

Facsimile: (202) 672-5399

By



William T. Ellis

Registration No. 26,874

Aaron C. Chatterjee

Registration No. 41,398

Attorneys for Applicants